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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,817	01/15/2002	Richard Allen Brown	214967	4741

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EXAMINER

JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/047,817

Applicant(s)

BROWN, RICHARD ALLEN

Examiner

Shaojia A Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 33-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This application claims priority to provisional application Serial No. 60/270047.

### ***Election/Restrictions***

Applicant's election with traverse of the invention of Group I, Claims 1-32 and 52 in Paper No. 3, submitted August 7, 2003 is acknowledged.

The traversal is on the ground(s) that no undue burden is placed upon the Office to search and examine the claims of Group I, II, and III together. This is not found persuasive because the invention of Group I and Group II are two separate and distinct since they have different modes of operation, as discussed in the Requirement for Restriction mailed July 1, 2003. See the restriction Requirement page 2. The invention Group III is seen to broadly teach a method of making a pigmented cosmetic composition generally, not specific compositions in Group I. The method for making could be used to make a materially different product than compositions in Group I such as different pigments, emulsifiers, preservatives, and vitamins in cosmetic compositions. Therefore, the inventions of Groups I, II, and III are seen to be separate and distinct inventions properly restricted from each other. Thus, the search for the inventions of both Groups I, II, and III would place an undue burden on the Office.

Note regarding the classification of the inventions herein that the search is not limited to the patent files. The search field for a composition is non-coextensive with the search field for a method of use employing the same composition. A reference to the composition herein would not necessarily be a reference to the method of treatment

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herein under 35 USC 103. The composition and method herein have separate consideration as to patentability.

The requirement is still deemed proper and is therefore made FINAL.

Claims 33-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 1-32 and 52 are examined on the merits herein.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-32 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitations "a pigment", "an emulsifier", "a sunscreensing agent", "a thickener", "an alcohol", and "a preservative" in the claims renders claims 1-32 and 52 indefinite. The recitations "a pigment", "an emulsifier", "a sunscreensing agent", "a thickener", and "a preservative" are not clearly defined in the specification. Hence, one of ordinary skill in the art could not interpret the metes and bounds of the patent protection desired as to what "a pigment", "an emulsifier", "a sunscreensing agent", "a thickener", and "a preservative" encompassed thereby.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 7-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Hollenbery et al. (US 5,143,722, PTO-892).

Hollenbery et al. discloses cosmetic or make-up (i.e., a foundation, eyeliner) compositions comprising water-in-oil emulsion comprising the instant ingredients such as an oil phase in amount about 30%, an aqueous phase for example 26% of water by weight which reads about 30%, a pigment herein and a sunscreensing agent such as titanium dioxide (TiO<sub>2</sub>), an emulsifier such as the surfactant therein and a thickener in amount for example 0.5% by weight, an inorganic salt such as sodium chloride, and a separation inhibitor, a silicone elastomer herein such as organopolysiloxane i.e., cyclomethicone in amount 22.6% for example, proylene glycol, and a preservative (see abstract, col.1-2, col.6 lines 11-68, Example 1-6 at col.7-8, and claims 1-15).

Applicant is further requested to note that it is well settled that "intended use" of a composition or product, e.g., make-up i.e., a foundation, eyeliner, will not further limit claims drawn to a composition or product. See, e.g., *Ex parte Masham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161.

Thus, the disclosure of Hollenbery et al. anticipates claims 1-4 and 7-32.

Claims 1-32 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Stepnieski et al. (US 5,599,533, PTO-892).

Stepnieski et al. discloses cosmetic compositions comprising water-in-oil emulsion comprising the instant ingredients such as an oil phase in the instant amount (see col.2 line 56 to col.3 line 18), an aqueous phase in the instant amount (see col.4 lines 55-58), a pigment herein, vitamin A and E, a sunscreensing agent such as titanium dioxide (TiO<sub>2</sub>) and a preservative (see col. 4 line 4 to col.5 .line 7), an emulsifier such as the surfactant therein and a thickener in the instant amount (col.3 lines 45-65), and a separation inhibitor, a silicone elastomer herein such as organopolysiloxane in the instant amount, i.e., cyclomethicone (see col.2 lines 19-45), prooylene glycol and an inorganic salt such as sodium chloride (see col.3 lines 51-61). See also abstract, Example 1-6 at col.5-6, and claims 1-40.

Thus, the disclosure of Stepnieski et al. anticipates claims 1-32 and 52.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877.

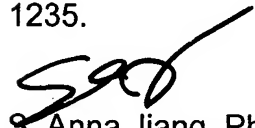
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The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

A handwritten signature in black ink, appearing to read 'S. Anna Jiang', is positioned above the printed name.

S. Anna Jiang, Ph.D.  
Patent Examiner, AU 1617  
October 3, 2003